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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,554	03/29/2004	Ivan Labonte	86421-39	1238

28291 7590 08/22/2006

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EXAMINER
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STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/810,554	<b>Applicant(s)</b> LABONTE, IVAN	
	<b>Examiner</b> Anthony Stashick	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 20-21 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Filice 6,381,877. Filice '877 discloses all the limitations of the claims including the following: a skate boot for enclosing a human foot (see Figure 1); the skate boot having a tongue 20 and an ankle portion with upper eyelets (see Figure 1); the flexing zone located above the upper eyelets of the ankle portion (that portion of the flexing zone located on the lower leg section above the ankle); the tongue comprising a first section 22 covering the forefoot of the foot; a second section 24 connected to said first section via a flexing zone 26, said flexing zone enabling said second section to be movable between a first position and a second position in relation to said first section (flexible so can fold over one another), in said first position, said second section covers a portion of the front ankle portion of the foot (see Figure 1); and in said second position, said second section overlaps a portion of said first section (fold 24 over 22 to insert foot into boot); said first section, said second section and said flexing zone are integrally formed (multiple pieces fastened together meets the definition of "integral", se Figure 4); the first section 22 is of a first thickness and the second section 24 is of a second thickness and the flexing zone 26 is of a third thickness (see Figure 4, flexing zone 26 does not include ridges and valleys 27); the third thickness is less than that of the first or second thickness (see Figure 4, third thickness appears to be at least half the thickness of the first and second thickness). With respect to the multiple flexing zones of Claim 24, the tongue of Filice '877 could be said to have two flexing zones, a top zone on the lower leg of the user and a bottom zone in front of the ankle of the user.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-5, 15-17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filice 6,381,877 as applied above in view of Marega et al. 5,289,645. Filice '877 as applied above discloses all the limitations substantially as claimed including the section comprising at least one flexing region for enabling the second section to expand laterally as it moves from the first to the second position (see Figure 6, portion 28). Filice '877 does not teach the flexing zone comprising a V-shaped groove. Marega et al. '645 teaches that the flexing portion (middle portion of the tongue between 14 and 18) can have a V-shaped groove (see Figure 3, V-shaped groove is in the width of the tongue) located therein to aid in helping the tongue flex when being used. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make a V-shaped groove in the side of the flexible portion of the tongue of Filice '877 as applied above to allow for more flexibility of the tongue while providing a better fit in the slit in the top of the shoe.

5. Claims 6-7 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied in paragraph 3 above in view of Hallenbeck 5,341,583. The references as applied in paragraph 3 above disclose all the limitations substantially as claimed except for the flexing region having a fourth thickness which is less than the first and second thickness and having a groove extending substantially perpendicular to the flexing zone. Hallenbeck '583 teaches that a groove (located in top portion of the tongue just beneath 17 in Figure 1) can be located in the second portion of the tongue. This groove, because the area where the groove is located would have a lesser thickness, would impart

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flexibility to the second portion of the shoe tongue while the tongue is expanding and the groove is perpendicular to the flex zone. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a groove anywhere on the tongue to impart more flexibility where needed, making that flexible area thinner than the first and second thickness.

6. Claims 8-9 and 14 are rejected under 35 U.S.C. 103(a) as being obvious over the references as applied to claim 4 above. The references as applied to claim 4 above disclose all the limitations substantially as claimed. The tongue of Filice '877 is shown in Figure 4 as being made up of multiple layers (see portions 22 and 24) and that these layers are attached to one another. Furthermore, Filice '877 shows that the first portion, flexing zone and second portion are integrally formed in as much that multiple parts fastened together meet the limitation of the term "integrally formed". While 22, 26 and 26 of Filice '877 comprise several parts, they are rigidly secured together as a single unit; constituent parts are so combined as to constitute a unitary whole, which is "integral" within meaning of claim; "integral" is not limited to a fabrication of parts from a single piece, but is inclusive of other means for maintaining parts fixed together as a single unit; moreover, use of one piece construction instead of reference structure is matter of obvious engineering choice.

7. Claims 10-13 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 9 above in view of Baychar 6,738,937. The references as applied to claim 9 above disclose all the limitations of the claims except for the layers of the tongue being made of foam and the type and relative density of the foam. Baychar '937 teaches that a boot tongue can be made of multiple layers of foam 320, 330 for protecting the user's feet and the densities of the foam being different with the second layer 320 being more dense than the first 330 (see col. 5, line 50-col. 6, line 6). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the tongue of the references as applied to claim 9 above out of layers of foam to aid in protecting the user's feet from impacts. With respect to the type of foam used, different types of foam,

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such as polyurethane and EVA are well known materials used in the shoe art for cushioning purposes. Therefore, it would have been obvious to use any known foam for the foam layers of the tongue of the references as applied above to aid in gaining cushioning for the user's foot during use of the skate.

### ***Response to Arguments***

8. Applicant's arguments filed June 12, 2006 have been fully considered but they are not persuasive. Applicant argues that Filice does not disclose that the second section of the tongue overlaps the first section. This can clearly be seen in Figure 7 of Filice since it is not necessary for the tongue portions to touch to be considered "overlapping". Furthermore, applicant argues that nowhere is it taught that the player "can wear the boot with the second section of the tongue overlapping its first section". Since this portion of the claim only requires the ability of the user to wear the boot in such a fashion, the user of the boot of Filice **can** wear the boot with the tongue overlapping during use since the boot does not need to be tied to "use" it, i.e. when walking. With respect to applicant's arguments directed to claim 20, they have been addressed in the rejections set forth above.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS